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Filing date: **12/03/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91213091
Party	Plaintiff Perine International Inc.
Correspondence Address	Jeffrey Schreiber Meister Seelig & Fein LLP 140 East 45th Street, 19th Floor New York, NY 10017 UNITED STATES js@msf-law.com,kaf@msf-law.com,sms@msf-law.com
Submission	Opposition/Response to Motion
Filer's Name	Susan M. Schlesinger
Filer's e-mail	js@msf-law.com,kaf@msf-law.com,sms@msf-law.com
Signature	/Susan M. Schlesinger/
Date	12/03/2013
Attachments	Opposer's Opposition to Applicant's Motion to Suspend.pdf(377361 bytes) Declaration in Support of Opposer's Opposition.pdf(1697498 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 85/917,605
Published in the *Official Gazette* on June 25, 2013

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Perine International Inc.	:	
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Opposer,	:	
	:	
v.	:	Opposition No.: 91213091
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	:	
Seena International Inc.,	:	
Applicant.	:	
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**OPPOSER'S OPPOSITION TO
APPLICANT'S MOTION TO SUSPEND OPPOSITION**

Opposer Perine International, Inc. ("Opposer" or "Perine"), through its undersigned counsel, hereby respectfully submits this memorandum of law in opposition to Applicant's Motion to Suspend Opposition ("Applicant's Motion") brought by Applicant Seena International, Inc. ("Applicant" or "Seena").

I. BACKGROUND

Applicant must be confused. It was Applicant that initiated its third current trademark application with the U.S. Patent and Trademark Office ("PTO") and, in fact, asked the PTO to expedite its application by filing a Petition to Make Special, which the PTO granted. (*See* Declaration of Susan M. Schlesinger ("Schlesinger Dec."), ¶¶ 2-3, Exs. A, B). Applicant claimed such treatment was necessary due to its belatedly-added common law trademark infringement and unfair competition counterclaims set forth in a pending state court action (the

“State Court Action”) and for alleged “additional litigations...for which Seena will need a federal trademark registration as soon as possible.” (*Id.* at ¶ 2, Ex. A, p. 8 ¶ 4).

Now, inexplicably, Applicant seeks to stay its own application for federal registration in favor of the State Court Action, which was commenced by Opposer as a result of Applicant’s breach of contract and failure to pay Opposer for goods sold and delivered (*see* Applicant’s Motion, Ex. A), and, moreover, which is pending in a forum that cannot make a determination as to federal registration.

In Applicant’s Motion, Applicant claims that such issues should be resolved by the judge in the State Court Action, rather than the PTO. (*See* Applicant’s Motion, p. 3-6). However, as discussed below, while common law trademark and unfair competition claims arising under the Lanham Act may be adjudicated before a state court judge, the authority of whether or not to issue a federal registration for a trademark lies with the PTO, as evidenced by Applicant’s filing of U.S. Application Serial No. 85/917,605 (the “‘605 Application”) and Petition to Make Special. Further, among Opposer’s grounds of opposition is that Applicant has committed fraud on the PTO during prosecution of the ‘605 Application. (*See* Dkt. #1). Such issue is clearly not within the purview of a state court to decide. *See e.g., Torres v. Cantine Torresella S.r.l.*, 808 F2d 46, 1 U.S.P.Q.2d 1483 (Fed. Cir. 1986). Moreover, while as a result of Applicant’s assertion of common law trademark infringement counterclaims, the validity of Applicant’s trademark will be raised in the State Court Action; such issues are tangential to the main issue of the State Court Action, i.e., Applicant’s failure to pay for goods that were sold and delivered to it by Opposer.

Accordingly, the TTAB is the best forum to decide issues regarding Seena’s ‘605 Application and, as such, Applicant’s Motion should be denied.

II. ARGUMENT

APPLICANT HAS FAILED TO SHOW GOOD CAUSE FOR SUSPENSION OF THE OPPOSITION PROCEEDING

While 37 C.F.R. § 2117(a) allows the Board to suspend a proceeding pending the outcome of a civil action or another Board proceeding, which may have bearing on the case before it, the decision to suspend is not absolute and is solely within the discretion of the Board. This discretionary right was discussed in *Jodi Kristopher Inc. v. International Seaway Trading Corp.*, 91 U.S.P.Q.2d 1957, 1958 (TTAB Jan. 30, 2009) (non-precedential) (denying motion to suspend proceeding where Board found it was a delaying tactic):

Suspension of a Board proceeding is solely within the discretion of the Board. ‘All motions to suspend, regardless of circumstances,...are subject to the ‘good cause’ standard [as cited in] Trademark Rule 2.117(c)...[T]he permissive language of Trademark Rule 2.117(a)...[also] make[s] clear that suspension is not the necessary result in all cases. (internal citations omitted)

In the proceeding at bar, Applicant has failed to show good cause to suspend the proceeding. Applicant asserts that this proceeding should be stayed pending the outcome of the State Court Action, wherein in response to Opposer’s breach of contract claims, Applicant, *over a year* after the State Court Action was commenced, asserted common law trademark infringement counterclaims. (*Id.*, Exs. A and B). These belated assertions in the State Court Action, inserted to cause additional delays therein, should not be the basis for suspending this opposition proceeding.

While a federal court, along with the PTO, has concurrent jurisdiction to determine rights relative to a registered trademark under 15 U.S.C. § 1119, state courts do not share such jurisdiction. State courts’ ability to hear trademark infringement claims under the Lanham Act is

independent of the PTO's decision on an applicant's registration and state court decisions are not binding on the PTO.

When presented with an application for registration, PTO tribunals must exercise their judgment in applying the Lanham Act provisions relating to registration independently of state court decisions ... Facts that may be established in such state litigation may be considered, but such facts must be applied in the light of federal law.

In re Marriott Corp., 517 F.2d 1364, 186 U.S.P.Q. 218, 222 (CCPA 1975).

Here, the main thrust of the State Court Action surrounds a contract dispute between Applicant and Opposer wherein Opposer is seeking a money judgment against Applicant for its failure to pay for goods sold and delivered to Applicant. (*See* Applicant's Motion, Ex. A). In response to Opposer's complaint in the State Court Action, Applicant alleges that the goods delivered were defective and/or not in conformity to the purchase orders with Opposer. (*Id.*, Ex. B). Accordingly, the essence of the dispute has nothing to do with Applicant's purported trademark rights or the '605 Application.

In addition, a resolution, if any, of Applicant's purported trademark infringement counterclaims in the State Court Action will not be swift as Applicant has done nothing but delay the progress of the State Court Action. For example, in response to the filing of the State Court Action, the Applicant immediately moved to dismiss the complaint merely because the Index No. was not listed on the Summons and Complaint and the Complaint was allegedly not signed. The Court summarily denied this motion. (*See* Schlesinger Dec., ¶ 4, Ex. C). The parties participated in a discovery conference before the state court and discovery was originally scheduled to be completed by December 2012. Then, in the end of January 2013, Applicant first notified the State Court and Opposer that it intended to file an amended answer with counterclaims, seeking to insert trademark infringement claims (though such filing did not occur

until April 29, 2013). (*See* Applicant's Motion, Ex. B). Following this revelation, and while the parties had agreed to depose Opposer's representative Na Lam (Linna) in February 2013, and after Ms. Lam travelled all the way to New York from Hong Kong, one of Applicant's representatives filed a bankruptcy petition claiming that such petition stayed the State Court Action (which it did not). (*See* Schlesinger Dec., ¶ 5, Ex. D). A month later, Applicant retained new counsel in the State Court Action who then asserted additional discovery needed to be conducted, and discovery has since continued. (*See* Schlesinger Dec., ¶ 6, Ex. E). Thus, the State Court Action, by Applicant's very own conduct, has slowly progressed and a resolution of Applicant's trademark application before the PTO would likely be resolved with more alacrity. This is likely what Applicant now fears, that the '605 Application will be denied registration in view of the instant opposition proceeding, which is why it now seeks to stay this proceeding pending the State Court Action.

Applicant asserts that its State Court Action counterclaims will require it to prove it is the valid owner of a protectable mark and, therefore, this opposition should be stayed. (*See* Applicant's Motion, p. 5-6). However, given that there is an existing application before the TTAB to determine that question, given the state court's inability to issue or deny a federal trademark registration, given Applicant's delaying tactics in the State Court Action and given that the real focus of the State Court Action is Applicant's failure to pay Opposer for goods sold and delivered, the TTAB is the more appropriate forum, and Applicant has failed to show good cause as to why this opposition proceeding should be suspended.

**THE STATE COURT ACTION AND THE OPPOSITION PROCEEDING
ARE INDEPENDENT OF EACH OTHER**

Tellingly, Applicant, when it thought it suited it, informed the state court that its pending trademark application in the PTO and its counterclaims in the State Court Action were *independent of each other*. In support of its motion to amend its pleadings in the State Court Action to assert common law trademark infringement claims, Applicant submitted the following to the State Court:

...the issue of the entitlement to register the mark, which is the issue determined in the registration proceeding, is different from, and therefore not dispositive of, the right to use the mark for purposes of an infringement action.....¹

This goes along with Applicant's Petition to Make Special wherein Applicant noted the differences between common law and federal trademark rights and why it sought separately to register its purported trademark. (*See* Schlesinger Dec. ¶ 2, Ex. A). Now, faced with the instant opposition proceeding, Applicant seeks to assert the opposite, namely, that the issues in the opposition proceeding and State Court Action are the same. Applicant has already recognized that proceedings regarding federal registration of a trademark and common law trademark rights are different. Applicant should not now be allowed to change its tune because it does not like the fact that the '605 Application is being opposed. Accordingly, Opposer should be allowed to continue the opposition proceeding against the '605 Application in view of Applicant's prior admissions that the State Court Action and registration-related proceedings are independent.

Likewise, Opposer notes that a third party, the Town of East Hampton, New York ("Town") has also opposed Applicant's '605 Application. (*See* Schlesinger Dec. ¶ 8, Ex. G). Town is not a party to the State Court Action, and while Applicant strains, in a similarly filed motion to suspend Town's opposition (*see* Schlesinger Dec. ¶ 8, Ex. H), to argue that the State

¹ *See* Schlesinger Dec. ¶ 7, Ex. F, p. 2.

Court Action is a reason for suspension of Town's opposition, the fact remains that the Town is independent of and has nothing to do with the State Court Action. Town should also be entitled to have the Town's opposition regarding the '605 Application adjudicated in a timely fashion to protect the interests of Town's constituents.

In all events, the TTAB is the proper forum for the resolution of Applicant's registrability issues. The TTAB has undoubtedly more experience than a state court, who can merely opine as to the validity of a trademark, and in reaching a decision can draw upon the array of trademark cases it has previously decided. In fact, a number of federal judicial jurisdictions have deferred to PTO determinations as it carries a strong presumption of validity and "[t]he findings of the Patent Office are not to be overturned lightly." *Radiator Specialty Co. v. Ladd*, 218 F.Supp. 827, 829, 138 U.S.P.Q. 284, 285 (DC DC 1963), *aff'd* 141 USPQ 622 (CADC 1964); *Kemin Industries, Inc. v. Watkins Products, Inc.*, 1974 WL 20194, 183 U.S.P.Q. 799 (D. Minn. 1974); *Watkins Products, Inc. v. Sunway Fruit Products, Inc.*, 311 F.2d 496, 499, 136 U.S.P.Q. 14 (7th Cir. 1962).

On the other hand, the cases cited by Applicant in support of a stay of the proceeding are inapposite. In almost all of the cases cited, the PTO stayed its proceedings in favor of a federal action, where the federal court was charged with deciding the outcome of a registration pursuant to the federal court's statutory authority.² Here, there is no federal court action and the State Court Action will not result in the issuance or denial of a trademark registration.

² Applicant's citations to the few cases where state court proceedings were at issue are equally unavailing. In *Argo & Co.* and in *NY- Exotics, Inc.*, at issue was the question of who was a proper party to file an application which involved state business incorporation issues. See *Argo & Co. v. Carpetsheen Mfg.*, 187 USPQ 366 (TTAB 1975); *NY-Exotics, Inc. v. Exotics.com, Inc.*, Can. No. 92040976 (TTAB 2006). Further, *Prof'l Economics Inc.* had nothing to do with a motion to suspend a current proceeding, rather, there had already been a determination in a prior state court action which was then later brought to light in a cancellation proceeding. See *Prof'l Economics Inc. v. Prof'l Economic Services, Inc.*, 205 U.S.P.Q. 368, 376 (TTAB 1979).

III. CONCLUSION

Applicant has not established the requisite good cause necessary for a suspension of this opposition proceeding. As such, Applicant's Motion to Suspend Opposition should be denied in its entirety, the opposition proceeding should go forward and Applicant should be required to answer the Notice of Opposition forthwith.

Dated: December 3, 2013

Respectfully Submitted,

/Susan M. Schlesinger/
Jeffrey Schreiber
Kevin A. Fritz
Susan M. Schlesinger
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New York, NY 10017
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Attorneys for Opposer

CERTIFICATE OF SERVICE AND FILING

The undersigned hereby certifies that a copy of the foregoing Opposer's Opposition to Applicant's Motion to Suspend Opposition was served on the Applicant on the date indicated below by depositing the same with the United States Postal Service, First Class Mail, postage pre-paid, to Applicant's correspondent address:

Michele P. Schwartz, Esq.
Crystal L. Jamison, Esq.
Andrews Kurth LLP
1717 Main Street, Suite 3700
Dallas, TX 75201

and further certifies that the aforementioned Opposer's Opposition to Applicant's Motion to Suspend Opposition was filed with the Trademark Trial and Appeal Board on the date indicated below online through the ESTTA system of the United States Patent and Trademark Office.

Dated: December 3, 2013

/Susan M. Schlesinger/
Susan M. Schlesinger

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 85/917,605
Published in the *Official Gazette* on June 25, 2013

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Seena International Inc.,	:	
Applicant.	:	
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DECLARATION OF SUSAN M. SCHLESINGER

I, Susan M. Schlesinger, pursuant to the requirements of 28 U.S.C. §1746, declare that the following is true and correct under the penalties of perjury:

1. I am associated with Meister Seelig & Fein LLP, counsel for Opposer, in Opposition No. 91213091 (the "Opposition"). I submit this declaration in support of Opposer's Opposition to Applicant's Motion to Suspend Opposition.

2. Attached as Exhibit A are true and correct copies of the relevant pages of Applicant's Petition to Make Special.

3. Attached as Exhibit B is a true and correct copy of the U.S. Patent and Trademark Office's grant of Applicant's Petition to Make Special.

4. Attached as Exhibit C is a true and correct copy of the opinion in the State Court Action denying Applicant's motion to dismiss the State Court Action.

5. Attached as Exhibit D is a true and correct copy of correspondence regarding the filing of a bankruptcy petition and the assertion that the State Court Action should be stayed in view of such petition.

6. Attached as Exhibit E is a true and correct copy of an order dated October 23, 2013 in the State Court Action regarding recent discovery obligations.

7. Attached as Exhibit F are true and correct copies of the relevant pages of Applicant's memorandum of law submitted in the State Court Action in support of its motion to amend its pleadings.

8. Attached as Exhibit G is a true and correct copy of a printout from the TTABVUE database showing the status of the pending opposition proceeding against U.S. Application Serial No. 85/917,605 filed by the Town of East Hampton, New York, Opposition No. 91213148.

9. Attached as Exhibit H are true and correct copies of the relevant pages of Applicant's Motion to Suspend Opposition filed in Opposition No. 91213148.

I hereby declare that the foregoing is true and correct under penalty of perjury.

Dated: December 3, 2013

/Susan M. Schlesinger/
Susan M. Schlesinger

Certificate of Service and Filing

The undersigned hereby certifies that a copy of the foregoing Declaration of Susan M. Schlesinger was served on the Applicant on the date indicated below by depositing the same with the United States Postal Service, First Class Mail, postage pre-paid, to Applicant's correspondent address:

Michele P. Schwartz, Esq.
Crystal L. Jamison, Esq.
Andrews Kurth LLP
1717 Main Street, Suite 3700
Dallas, TX 75201

and further certifies that the aforementioned Declaration of Susan M. Schlesinger was filed with the Trademark Trial and Appeal Board on the date indicated below online through the ESTTA system of the United States Patent and Trademark Office.

Dated: December 3, 2013

/Susan M. Schlesinger/
Susan M. Schlesinger

EXHIBIT A

Petition to Make Special

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85917605
REGISTRATION NUMBER	
FORM TEXT	<p>Applicant is petitioning to make the prosecution of Serial No. 85917605 for the DITCH PLAINS word mark special because the mark is currently being counterfeited/infringed and is the subject of a pending litigation in New York State Court. Attached hereto is the Declaration of Mary L. Grieco, further explaining the specific facts relating to the pending litigation and attaching the Proposed Amended Answer, Counterclaims and Cross-Claims.</p> <p>Based on the pending litigation regarding the counterfeited/infringed DITCH PLAINS apparel products, Applicant respectfully requests that this special action be granted.</p>
ATTACHMENT(S)	
ORIGINAL PDF FILE	<u>Grieco Declaration with exhibit 20134294638367.pdf</u>
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PAYMENT SECTION	
NUMBER OF CLASSES	1
FEE PER CLASS	100
TOTAL FEES DUE	100
SIGNATURE SECTION	
DECLARATION SIGNATURE	/marylgrieco/
SIGNATORY'S NAME	Mary L. Grieco
SIGNATORY'S POSITION	Attorney of Record, NY State Bar Member
SIGNATORY'S PHONE NUMBER	212-451-2300
DATE SIGNED	05/02/2013
SUBMISSION SIGNATURE	/marylgrieco/
SIGNATORY'S NAME	Mary L. Grieco
SIGNATORY'S POSITION	Attorney of Record, NY State Bar Member
SIGNATORY'S PHONE NUMBER	212-451-2300
DATE SIGNED	05/02/2013
AUTHORIZED SIGNATORY	YES
FILING INFORMATION SECTION	
TEAS STAMP	USPTO/PMS-10.112.151.171- 20130502095211211073-8591 7605-20130502093411108035 -DA-8285-2013050209341110 8035

**Petition to Make Special
To the Commissioner for Trademarks:**

The following is submitted for application serial number. **85917605** :

FORM INFORMATION

Applicant is petitioning to make the prosecution of Serial No. 85917605 for the DITCH PLAINS word mark special because the mark is currently being counterfeited/infringed and is the subject of a pending litigation in New York State Court. Attached hereto is the Declaration of Mary L. Grieco, further explaining the specific facts relating to the pending litigation and attaching the Proposed Amended Answer, Counterclaims and Cross-Claims.

Based on the pending litigation regarding the counterfeited/infringed DITCH PLAINS apparel products, Applicant respectfully requests that this special action be granted.

FORM FILE NAME(S)

Original PDF file:

Grieco Declaration with exhibit [20134294638367.pdf](#)

Converted PDF file(s) (45 pages)

[Attachments-1](#)

[Attachments-2](#)

[Attachments-3](#)

[Attachments-4](#)

[Attachments-5](#)

[Attachments-6](#)

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Attachments-43
Attachments-44
Attachments-45

FEE(S)

Fee(s) in the amount of \$100 is being submitted.

SIGNATURE(S)

Declaration Signature

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that the facts set forth above are true; all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

Signature: /marylgrieco/ Date: 05/02/2013

Signatory's Name: Mary L. Grieco

Signatory's Position: Attorney of Record, NY State Bar Member

Signatory's Phone Number: 212-451-2300

Submission Signature

Signature: /marylgrieco/ Date: 05/02/2013

Signatory's Name: Mary L. Grieco

Signatory's Position: Attorney of Record, NY State Bar Member

Signatory's Phone Number: 212-451-2300

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the petitioner's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the petitioner in

this matter: (1) the petitioner has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the petitioner has filed a power of attorney appointing him/her in this matter; or (4) the petitioner's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

RAM Sale Number: 8285

RAM Accounting Date: 05/02/2013

Serial Number: 85917605

Internet Transmission Date:

TEAS Stamp: USPTO/PMS-10.112.151.171-201305020952112

11073-85917605-20130502093411108035-DA-8

285-20130502093411108035

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

-----X
In re Application of

Applicant : SEENA INTERNATIONAL, INC.

Serial No. : 85/917,605

Mark : DITCH PLAINS

Class : 25
-----X

DECLARATION UNDER 37 C.F.R. §2.20

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any resulting registration, declares as follows:

1. I am a partner at Olshan Frome Wolosky LLP and counsel for Seena International, Inc. ("Seena" or "Applicant"). I submit this declaration in support of Applicant's Petition to make the prosecution of Serial No. 85/917,605 for the DITCH PLAINS word mark special. This request is being made because the DITCH PLAINS trademark is currently being counterfeited/infringed and is the subject of proposed counterclaims in a pending litigation in New York State Court, namely, *Perine International, Inc. v. Bedford Clothiers, Inc., et al.*, Index No. 650040/12 (the "Perine Litigation"). A copy of the proposed Counterclaims and Cross-Claims are attached hereto as Exhibit 1 (the "Proposed Pleading").

2. Specifically, as detailed in the Proposed Pleading, upon information and belief, without the consent of Applicant, Perine International, Inc. and its affiliates, designed, manufactured, exported, imported, distributed, advertised, offered for sale, and/or sold, throughout the United States and in New York state, apparel products bearing identical reproductions of the Ditch Plains word mark and logo, along with an identical neck label, and identical surfer hangtag and/or the surfboard hangtag (the "Infringing Goods").

3. Upon information and belief, the Infringing Goods consist of studied imitations of pre-existing DITCH PLAINS styles and/or patterns or Applicant's other trademarked products. As such, upon information and belief, the Infringing Goods are competitive with, related to, and are directed and targeted towards the same group of Applicant's customers and ultimate consumers as Applicant's authentic DITCH PLAINS' apparel products.

4. On April 29, 2013, this firm filed a Motion for Leave to Amend in the Perine Litigation to add claims for violations of 15 U.S. C. § 1125(a), common law trademark infringement, common law unfair competition and violations of New York State Law. Because Seena does not presently have a federal trademark registration, we were unable to include federal trademark infringement and counterfeiting claims at this time, pursuant to 15 U.S.C. § 1114. Nonetheless, we expect that additional litigations will result from the distribution and sale of the Infringing Goods, for which Seena will need a federal trademark registration as soon as possible.


5. Due to the pending litigation and the anticipated additional litigations, Seena's Petition to Make special is justified and should be granted. As such, we respectfully request that the prosecution of Serial No. 85/917,605 be made special and that the application be permitted to pass to registration on an expedited basis.

6. The facts set forth herein are true; all statements made of my knowledge are true, and all statements made on information and belief are believed to be true.

OLSHAN FROME WOLOSKY LLP

Date: April 30, 2013

By:



Mary L. Grieco

EXHIBIT B



Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
www.uspto.gov

May 9, 2013

MARTIN J. FEINBERG, MARY L. GRIECO, SAFI
OLSHAN FROME WOLOSKY LLP
65 E 55TH ST
NEW YORK, NY 10022-3219

Re: Serial No 85/917605
Applicant: Seena International, Inc.
Mark: DITCH PLAINS

Dear Ms. Grieco:

This acknowledges receipt on May 2, 2013 of your petition to make special filed in connection with the above-identified trademark application. Your petition to make special has been considered by the Office of the Commissioner for Trademarks and has been found to meet all requirements. 37 C.F.R. §2.146 and TMEP §§1710 and 1710.01.

Decision: Petition to make special is hereby GRANTED.

The trademark application will be returned to Law Office 103 and will be handled in accordance with TMEP §§702.02 and 1710.02.

Sincerely,

/Deborah D. Mays/
Deborah D. Mays
Paralegal Specialist
Petitions Office
Phone: 571 272-9575
Fax: 571 273-9575
deborah.mays@uspto.gov

EXHIBIT C

**SUPREME COURT OF THE STATE OF NEW YORK
NEW YORK COUNTY**

PRESENT: BARBARA R. KAPNICK

PART 39

Justice

Index Number : 650040/2012
PERINE INTERNATIONAL INC.
vs.
BEDFORD CLOTHIERS, INC.
SEQUENCE NUMBER : 001
DISMISS

INDEX NO. _____

MOTION DATE _____

MOTION SEQ. NO. _____

The following papers, numbered 1 to _____, were read on this motion to/for _____

Notice of Motion/Order to Show Cause — Affidavits — Exhibits _____ No(s). _____

Answering Affidavits — Exhibits _____ No(s). _____

Replying Affidavits _____ No(s). _____

Upon the foregoing papers, it is ordered that this motion is

**MOTION IS DECIDED IN ACCORDANCE WITH
ACCOMPANYING MEMORANDUM DECISION**

MOTION/CASE IS RESPECTFULLY REFERRED TO JUSTICE
FOR THE FOLLOWING REASON(S):

Dated: 5/2/12


BARBARA R. KAPNICK
J.S.C.

1. CHECK ONE: ☐ CASE DISPOSED ☒ NON-FINAL DISPOSITION
2. CHECK AS APPROPRIATE: MOTION IS: ☐ GRANTED ☐ DENIED ☒ GRANTED IN PART ☐ OTHER
3. CHECK IF APPROPRIATE: ☐ SETTLE ORDER ☐ SUBMIT ORDER
- ☐ DO NOT POST ☐ FIDUCIARY APPOINTMENT ☐ REFERENCE

SUPREME COURT OF THE STATE OF NEW YORK
COUNTY OF NEW YORK: IA PART 39

-----X
PERINE INTERNATIONAL INC.,

Plaintiff,

- against -

BEDFORD CLOTHIERS, INC.,

Defendant.

-----X
BARBARA R. KAPNICK, J.:

DECISION/ORDER

Index No. 650040/12

Motion Seq. No. 001

That portion of defendants' motion for an order (a) dismissing the Complaint pursuant to CPLR 3211(a)(2) or (8) due to plaintiff's failure to abide by the requirements of CPLR 305; or (b) striking the Complaint for plaintiff's failure to comply with the provisions of 22 NYCRR 130-1.1-a is denied in accordance with the decision dictated on the record on May 2, 2012.

That portion of defendants' motion seeking an order pursuant to CPLR 8501(a) directing plaintiff to post security for costs is granted in the amount of \$500.00. Therefore, it is

Ordered that, within 30 days from the date of service of a copy of this Order with Notice of Entry, the plaintiff either (i) pay into the Court the sum of \$500.00 (payable in cash, credit card [Mastercard or Visa], certified check or bank check) to be applied to the payment of costs, if any, awarded against the plaintiff, or (ii) at its election, file with the County Clerk (Room 141 B) an

undertaking with sufficient surety in a like amount to be applied to the payment of costs, if any, awarded against the plaintiff in this action; and it is further

Ordered that, within said 30-day period, plaintiff serve upon the attorneys for the defendant a written notice of the aforesaid payment or of the filing of such undertaking; and it is further

Ordered that defendants shall serve and file an Answer within twenty (20) days of the date of this Order, and plaintiff shall file its reply to any counterclaims asserted by defendants in their Answer within twenty (20) days thereafter; and it is further

Ordered that counsel are directed to appear for a preliminary conference in IA Part 39, Room 208, 60 Centre Street, on June 13, 2012 at 10:00 am.

This constitutes the decision and order of this Court.

Date: *May 2*, 2012



Barbara R. Kapnick
J.S.C.

BARBARA R. KAPNICK
J.S.C.

EXHIBIT D

JONATHAN A. STEIN, P.C.

ATTORNEY AND COUNSELOR AT LAW
132 SPRUCE STREET
CEDARHURST, NEW YORK 11516-1915

MEMBER OF NY AND NJ BARS

TELEPHONE
(516) 295-0958

TELECOPIER
(516) 295-0857

e-mail: jonsteinlaw@gmail.com

February 22, 2013

VIA TELECOPIER (212) 401-9154

Honorable Barbara R. Kapnick, J.S.C.
Supreme Court, New York County
60 Centre Street
New York, New York 10007

RE: *Perine International, Inc. v. Bedford Clothiers, Inc., et al.*
Sup. Ct., N.Y. Co., Index No. 650040/12

Honorable Madam:

I am writing to you in response to a letter by Plaintiff's attorney Kevin Fritz of even date, which was sent to me at 1:13 p.m. Notwithstanding the fact that proof of the bankruptcy filing was sent to Mr. Fritz's firm at 11:49 a.m. today, Mr. Fritz only references my earlier advice to him as to what I had been told had happened or was imminently going to happen. Attached is a copy of the letter the debtor's counsel sent to Plaintiff's counsel this morning with the proof of facsimile transmission and proof of filing of the bankruptcy petition.

I am also attaching a cleaner copy of the proof of filing.

I have separately spoken to more than one bankruptcy attorney on this matter and have even consulted with a bankruptcy judge (not the one assigned to this case) who I represent on a separate civil matter. I am advised that while Plaintiff may move to sever the non-debtor defendants and proceed against them, that application must be made in bankruptcy court. In fact, it is the debtor's actions which Plaintiff claims to have been the *sine qua non* for the release of the goods that are at issue in this case.

At this point it is our position that pending relief from the automatic stay and severance of the non-debtor defendants, this action is stayed.

In light of this we are also requesting that the Court adjourn *sin die* the compliance conference currently scheduled for March 6, 2013.

As for the claim that I was being disrespectful to Ms. Rodriguez, I am personally offended. I was merely trying to point out to Mr. Fritz that a reference to the "Court" is of necessity a reference

Honorable Barbara R. Kapnick, J.S.C.

Page 2

RE: *Perine Int'l v. Bedford Clothiers* Index No. 650040/12
February 22, 2013

to Your Honor – not other court personnel. In over thirty-one years of practice I have never been accused of showing disrespect to either the Court or my fellow practitioners. There was nothing incorrect or disrespectful in my e-mail response to Mr. Fritz.

We thank the Court for its attention to this matter, and respectfully, opine that the automatic stay precludes the current consideration of Plaintiff's proposed order to show cause.

Most Respectfully Yours,



JONATHAN A. STEIN

JAS:rf

Enclosures

cc: Kevin A. Fritz, Esq.

Todd A. Gabor, Esq.

Jeffrey Schreiber, Esq.

2502546600

P.01/01

TRANSACTION REPORT

FEB/22/2013/FRI 11:49 AM

FAX(TX)

#	DATE	START T.	RECEIVER	COM.TIME	PAGE	TYPE/NOTE	FILE
001	FEB/22	11:48AM	912126553535	0:00:34	3	MEMORY OK	593 3276

LAW OFFICE OF
NARISSA A. JOSEPH
 277 BROADWAY, SUITE 501
 NEW YORK, NY 10007

TEL: 212-233-3060, FAX (212) 608-0304

Email: njosephlaw@aol.com . www.njlegaloffices.com

Admitted in NY & NJ

February 22, 2013

VIA FAX (212) 655-3535:
Meister, Seelig & Fein, LLP
 140 East 45th Street, 19th Floor
 New York, NY 10017

Re: Srinivas Kothapally, -Date Filed 02/22/2013-Case No.: 13-40936;
 In Reference: Perine International, Inc. v. Bedford Clothiers, Inc., Seena International
 Inc., Ricky Singh, Brooklyn Xpress, and Vasu Kothapally Index No.: 650040/2012

Dear Sir/Madam:

The above-named debtor, whom I represent, filed a petition for relief under chapter 7 of the Bankruptcy Code in the United States Bankruptcy Court for the Eastern District of New York.

As you may be aware, the debtor's Chapter 7 filing forces you to cease your collection efforts. This prevents you from commencing or continuing any act to collect a pre-petition debt. Please discontinue any collection actions you may have commenced against the debtor. Violation of the automatic stay constitutes contempt of court and will lead to the imposition of sanctions. 11 U.S.C. § 362(h). Please stop the pending proceeding.

The automatic stay is effective as of the moment of filing of the bankruptcy petition. 11 U.S.C. § 362; *In Re Stucka*, 77 B.R. 777 (Bkrty C.D. Cal. 1987). Furthermore, the automatic stay is effective even though the creditor may have received no notice whatever of it. 11 U.S.C. §362(a); *In re Kim*, 71 B.R. 1011 (Bkrty C.D. Cal. 1987). Any action done in violation of the automatic stay is void. 11 U.S.C. §362. After a discharge is granted and a case is closed, an injunction is issued by the court prohibiting you from collecting pre-petition debts.

Immediately, stop the pending law suit.

Sincerely,

 Tasha Townsend

LAW OFFICE OF
NARISSA A. JOSEPH

277 BROADWAY, SUITE 501
NEW YORK, NY 10007

TEL: 212-233-3060. FAX (212) 608-0304

Email: njosephlaw@aol.com . www.njlegalsoffices.com

Admitted in NY & NJ

February 22, 2013

VIA FAX (212) 655-3535:

Meister, Seelig & Fein, LLP
140 East 45th Street, 19th Floor
New York, NY 10017

Re: Srinivas Kothapally. -Date Filed 02/22/2013-Case No.: 13-40936;
In Reference: Perine International, Inc. v. Bedford Clothiers, Inc., Seena International
Inc., Ricky Singh, Brooklyn Xpress, and Vasu Kothapally Index No.: 650040/2012

Dear Sir/Madam:

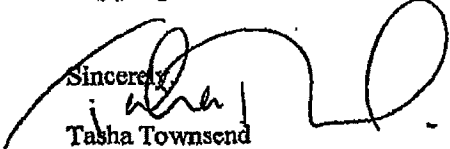
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Immediately, stop the pending law suit.

Sincerely,


Tasha Townsend

LEGAL ASSISTANT

Live Database: nyeb_live

Page 1 of 2

United States Bankruptcy Court
Eastern District of New York

Notice of Bankruptcy Case Filing

A bankruptcy case concerning the debtor(s) listed below was filed under Chapter 7 of the United States Bankruptcy Code, entered on 02/22/2013 at 11:25 AM and filed on 02/22/2013.

Srinivas Kothapally
14912 Barclay Avenue
Flushing, NY 11355
SSN / ITIN: xxx-xx-5296



The case was filed by the debtor's attorney:

Narissa A Joseph
277 Broadway
Suite 501
New York, NY 10007
(212) 233-3060

The case was assigned case number 1-13-40936.

In most instances, the filing of the bankruptcy case automatically stays certain collection and other actions against the debtor and the debtor's property. Under certain circumstances, the stay may be limited to 30 days or not exist at all, although the debtor can request the court to extend or impose a stay. If you attempt to collect a debt or take other action in violation of the Bankruptcy Code, you may be penalized. Consult a lawyer to determine your rights in this case.

If you would like to view the bankruptcy petition and other documents filed by the debtor, they are available at our *Internet* home page <https://ecf.nyeb.uscourts.gov/> or at the Clerk's Office, 271-C Cadman Plaza East, Suite 1595, Brooklyn, NY 11201-1800.

You may be a creditor of the debtor. If so, you will receive an additional notice from the court setting forth important deadlines.

Robert A. Gavin, Jr.
Clerk, U.S. Bankruptcy
Court

Live Database: nyeb_live

Page 2 of 2

PACER Service Center			
Transaction Receipt			
02/22/2013 11:33:01			
PACER Login:	nf0017	Client Code:	
Description:	Notice of Filing	Search Criteria:	1-13-40936
Billable Pages:	1	Cost:	0.10

United States Bankruptcy Court
Eastern District of New York

Notice of Bankruptcy Case Filing

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You may be a creditor of the debtor. If so, you will receive an additional notice from the court setting forth important deadlines.

Robert A. Gavin, Jr.
Clerk, U.S. Bankruptcy
Court

PACER Service Center			
Transaction Receipt			
02/22/2013 11:33:01			
PACER Login:	nf0017	Client Code:	
Description:	Notice of Filing	Search Criteria:	1-13-40936
Billable Pages:	1	Cost:	0.10

EXHIBIT E

SUPREME COURT OF THE STATE OF NEW YORK
COUNTY OF NEW YORK

Perine International

✓

Bedford Clothiers, Inc., et. al.

INDIVIDUAL ASSIGNMENT PART 39

STIPULATION

INDEX NO. 65004012

MOTION CALENDAR NO.

DATE 10/23/13

IT IS HEREBY STIPULATED AND AGREED by and between the below-named attorney(s) as follows:

- ① Defendants shall serve and file their Amended Verified Answer upon plaintiff, if not done so already, on October 23, 2013. Plaintiff shall reply serve its Reply on or before November 12, 2013.

- ② Plaintiff shall ~~file and~~ serve its ~~copy~~ ^{and Document Demands and} ~~on~~ ^{interrogatory} on or before ~~November 28, 2013~~ October 28, 2013.

- ③ Defendants shall respond to such demands including any document production ^{within 30 (thirty) days of receipt.} ~~on or before October 4, 2013.~~

- ④ ~~Defendants~~ ^{proposed} All parties will exchange the dates for depositions on or before November 1, 2013.

- ⑤ Defendants shall inform plaintiff of any outstanding document deficiencies on or before November 4, 2013.

- ⑥ Status conference
12/4/13 at 10:30 a.m.

Date: 10/23/13

Attorney for Plaintiff

Andrew Kurth by Lillman
Attorney for Defendant s

So Ordered.

Attorney for Defendant

ENTER:

BARBARA R. KAPNICK J.S.C.
J.S.C.

EXHIBIT F

**DEFENDANTS' REPLY MEMORANDUM OF LAW IN FURTHER SUPPORT OF
MOTION FOR LEAVE TO SERVE AND FILE AN AMENDED VERIFIED ANSWER
WITH CROSS-CLAIMS AND COUNTERCLAIMS**

ANDREWS KURTH LLP
Attorneys for Defendants
450 Lexington Avenue, 15th Floor
New York, NY 10017
(212) 850-2800

Defendants Bedford Clothiers, Inc. (“Bedford”), Seena International Inc. (“Seena”), Ricky Singh and Brooklyn Xpress, by and through their attorneys Andrews Kurth LLP, submit this Reply Memorandum of Law in further support of their motion to amend (the “Motion to Amend”) and file an Amended Verified Answer with Counterclaims and Cross-Claims (the “Proposed Pleading”).

Preliminary Statement

Plaintiff fails to raise any viable contention in opposition to the Motion to Amend. Plaintiffs’ lead argument, that Defendants have no protectable interest in their “DITCH PLAINS” mark, is entirely meritless. Defendants are not “collaterally estopped” from asserting their rights in the mark by reason of agency determinations concerning the registrability of the mark. Nor is the “DITCH PLAINS” mark “geographically deceptively misdescriptive.” As for Plaintiff’s assorted other arguments -- which involve such issues as Defendants’ error with respect to the “first use” date of their mark; the purported lack of involvement of the Perine Parties in the sale of infringing goods; the specificity of the proposed claims against the Perine Parties; the sufficiency of the “consumer injury” element of the proposed claim under the New York General Business Law (“GBL”); and the alleged “prejudice” to the Perine Parties if the Motion to Amend is granted -- are either wrong as a matter of law or distort the liberal standard applicable to motions under CPLR 3025 by seeking to place upon Defendants the burden of proving the allegations in the Proposed Pleading.

ARGUMENT

I.

PLAINTIFF'S CONTENTION THAT SEENA HAS NO TRADEMARK RIGHTS IN "DITCH PLAINS" IS MERITLESS

Plaintiff's arguments that Seena has no trademark rights in "Ditch Plains" because it is "collaterally estopped" from asserting any rights to the mark and that "Ditch Plains" is not entitled to protection because it is "geographically deceptively misdescriptive" (Plaintiffs' Brief in Opposition ("Opp. Br.") at 2-8) are both without merit.

A. No Collateral Estoppel Applies to the TTAB Decision

Plaintiff asserts that Seena is collaterally estopped from claiming possession of a valid mark in "DITCH PLAINS" because the Trademark Trial and Appeal Board ("TTAB") affirmed the refusal by the Patent and Trademark Office ("PTO") to register the mark in an *ex parte* proceeding. (Opp. Br. at 2-4)

For collateral estoppel to apply, the issues in the earlier proceeding must have been identical to the issue in the later one. *Levy v. Kosher Overseers Ass'n of Am.*, 104 F.3d 38, 41 (2d Cir. 1997). It is well-established that registration proceedings before the PTO and TTAB have no collateral estoppel effect in a subsequent trademark infringement action involving the same mark. *E.g., Tonka Corp. v. Rose Art Indus., Inc.*, 836 F. Supp. 200, 214-15 (D.N.J. 1993); 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* ("McCarthy on Trademarks") (4th ed. 2013), §32:84 at 32-202-203, n. 5. This is because the issue of the entitlement to register the mark, which is the issue determined in the registration proceeding, is different from, and therefore not dispositive of, the right to use the mark for purposes of an infringement action. *Tonka*, 836 F. Supp. at 213.¹

¹ As a rule, *ex parte* determinations by the PTO or the TTAB regarding the registrability of a mark have no binding or preclusive effect in a subsequent *inter partes* action involving the mark. *See McCarthy on*

Thus, denial of registration has absolutely no effect upon the ability to enforce common law rights to the mark. See McCarthy on Trademarks, §32:95 at 32-222-223 (“It is clear that an *ex parte* refusal to register a mark does not estop the owner from asserting common law rights in the mark.”); *Volkswagenwerk Aktiengesellschaft v. Wheeler*, 814 F.2d 812, 819 (1st Cir. 1987) (“A refusal by the PTO to register a mark does not preclude the owner of the mark from his right to use it. [citation omitted] ... A plaintiff need not rely on federal registration to establish a claim for trademark infringement.”).²

In the present case, therefore, the denial of registration by the PTO/TTAB has no preclusive effect upon Defendants’ proposed infringement claims, as those determinations did not involve or affect Defendants’ right to protect their unregistered mark. Indeed, no identity of issues exists between the PTO/TTAB *ex parte* proceedings and the proposed claims by Defendants in the present case against Plaintiff and the proposed additional parties, which were not parties to the PTO/TTAB proceedings. In denying registration to the “DITCH PLAINS” mark on the basis of its similarity to the registered mark of Anvil NY LLC (“Anvil”), the PTO/TTAB neither considered nor determined the key issue underlying Defendants’ Proposed Pleading, *i.e.*, whether Seena can enforce its rights in “DITCH PLAINS” against Plaintiff. See, *e.g.*, *Levy*, 104 F.3d at 42 (collateral estoppel inappropriate where “factual basis for likelihood of confusion” and issues not the same). Accordingly, collateral estoppel is inapplicable. The issue of whether Seena’s mark is confusingly similar to Anvil’s has nothing whatsoever to do with Plaintiff’s infringements of Seena’s mark.

Trademarks, §32:94 at 32-218 - 219. See also *D.M. Antique Import Corp. v. Royal Saxe Corp.*, 311 F. Supp. 1261, 1274 (S.D.N.Y. 1971) (although the court accords “respectful consideration” to determinations of the PTO, it is not bound by them).

² For this reason, Plaintiff’s argument (Opp. Br. at 9-10) that Defendants cannot attempt to claim a “valid, protectable mark after-the-fact” of the PTO/TTAB determinations must be rejected.

While Plaintiff would not be prejudiced by the granting of this motion, Defendants, on the other hand, would be prejudiced by the denial of this motion, as the issues in the Proposed Pleading are inextricably intertwined with those in Plaintiff's claim, involving the very same goods, and should be adjudicated in the same case to conserve judicial resources.

Conclusion

For the foregoing reasons, Defendants respectfully request that their Motion to Amend be granted.

Dated: New York, New York
August 1, 2013

ANDREWS KURTH LLP

By: /s/ Anju Uchima
Lynne M. Fischman Uniman
Anju Uchima
450 Lexington Avenue, 15th Floor
New York, NY 10017
(212) 850-2800
(212) 850-2929 (fax)
Attorneys for Defendants

EXHIBIT G



United States Patent and Trademark Office

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TTABVUE. Trademark Trial and Appeal Board Inquiry System

v1.5

Opposition

Number: 91213148**Filing Date:** 10/23/2013**Status:** Pending**Status Date:** 10/23/2013**Interlocutory Attorney:** CHERYL S GOODMAN**Defendant****Name:** Seena International, Inc.**Correspondence:** MICHELE P SCHWARTZ

ANDREWS KURTH LLP

1717 MAIN STREET, SUITE 3700

DALLAS, TX 75201

UNITED STATES

mps@akllp.com, luniman@akllp.com, anjuuchima@andrewskurth.com,

cjamison@akllp.com, kneal@akllp.com, dallasipdocket@akllp.com,

mschwartz@akllp.com, nea

Serial #: 85917605Application File**Application Status:** Opposition Pending**Mark:** DITCH PLAINS**Plaintiff****Name:** Town of East Hampton**Correspondence:** JOHN C JILNICKI

TOWN OF EAST HAMPTON

159 PANTIGO ROAD

EAST HAMPTON, NY 11937

UNITED STATES

jjilnicki@ehamptonny.gov

Prosecution History

#	Date	History Text	Due Date
<u>6</u>	11/19/2013	<u>D MOT TO SUSP PEND DISP CIV ACTION</u>	
<u>5</u>	11/13/2013	<u>D CHANGE OF CORRESP ADDRESS</u>	
<u>4</u>	10/30/2013	<u>D APPEARANCE / POWER OF ATTORNEY</u>	
<u>3</u>	10/23/2013	PENDING, INSTITUTED	
<u>2</u>	10/23/2013	<u>NOTICE AND TRIAL DATES SENT; ANSWER DUE:</u>	12/02/2013
<u>1</u>	10/23/2013	<u>FILED AND FEE</u>	

Results as of 12/03/2013 02:41 PM

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EXHIBIT H

ESTTA Tracking number: **ESTTA571767**

Filing date: **11/19/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91213148
Party	Defendant Seena International, Inc.
Correspondence Address	MICHELE P SCHWARTZ ANDREWS KURTH LLP 1717 MAIN STREET, SUITE 3700 DALLAS, TX 75201 UNITED STATES mps@akllp.com, luniman@akllp.com, anjuuchima@andrewskurth.com, cjamison@akllp.com, kneal@akllp.com, dallasipdocket@akllp.com, mschwartz@akllp.com
Submission	Motion to Suspend for Civil Action
Filer's Name	Michele P. Schwartz
Filer's e-mail	mps@akllp.com, cjamison@akllp.com, luniman@akllp.com, auchima@andrewskurth.com, nealk@akllp.com, dallasipdocket@akllp.com
Signature	/Michele P. Schwartz/
Date	11/19/2013
Attachments	SEENA - Motion to Suspend Opposition v Town of E Hampton.pdf(23457 bytes) Ex A.pdf(312660 bytes) Ex B.pdf(959766 bytes) Ex C.pdf(159908 bytes) Ex D.pdf(558297 bytes) Ex E.pdf(722789 bytes) Ex F.pdf(392680 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 85/917,605
Published in the Official Gazette on June 25, 2013
MARK: Ditch Plains

TOWN OF EAST HAMPTON)	
)	
Opposer,)	
v.)	Opposition No. 91213148
)	
SEENA INTERNATIONAL, INC.)	
)	
Applicant.)	

APPLICANT’S MOTION TO SUSPEND OPPOSITION

Pursuant to 37 C.F.R. § 2.117(a), Applicant Seena International, Inc. (“Applicant” or “Seena”) moves to suspend the above-captioned opposition proceeding (the “Opposition”) pending disposition of Civil Action Index. No. 650040/2012, filed by Perine International, Inc. (“Perine”) against, *inter alia*, Applicant in the Supreme Court of the State of New York (hereinafter, the “Civil Action”). Perine’s Verified Complaint, Seena’s and the other defendants’ Amended Verified Answer with Counterclaims and Cross-Claims (“Answer with Counterclaims”) and Perine’s Verified Reply to the Amended Counterclaims (“Reply to Counterclaim”) filed in the Civil Action are attached hereto as Exhibits A, B and C, respectively. Prior to filing this Motion, Applicant made several attempts to confer with counsel for Town East Hampton (“Town” or “Opposer”) regarding whether Opposer consented to suspension, but Applicant was unable to obtain a response.

I. RELEVANT BACKGROUND

On October 23, 2013, Town filed a Notice of Opposition, opposing registration of Application No. 85/917,605 for the mark DITCH PLAINS, a mark that Seena has used continuously in U.S. commerce since at least as early as October 31, 2005. (Ex. B, Answer with

Countercl.¶ 42.) Seena has expended over a half million dollars in advertising, establishing the goodwill associated with the DITCH PLAINS mark. (*Id.* at ¶ 43.) In the Notice of Opposition, Opposer Town does not allege prior use of the DITCH PLAINS mark or similar marks, nor does it allege likelihood of confusion between the DITCH PLAINS mark and any mark owned by Town. Instead, Opposer claims that Seena should not be entitled to register its mark because Seena's use of the DITCH PLAINS mark is geographically deceptively misdescriptive (Not. of Opp'n ¶¶ 6-7).

Approximately nineteen months earlier, on January 6, 2012, Perine filed a Civil Action alleging claims relating to an agreement to manufacture Seena's products featuring Seena's DITCH PLAINS mark. On May 22, 2012, Seena filed an Answer asserting contract-related counterclaims. After filing the Answer, Seena learned that Perine had sold unauthorized and infringing goods bearing Seena's DITCH PLAINS mark, prompting Seena to file a Motion to amend its Answer and Counterclaim on April 29, 2013, attached hereto as Exhibit D. In the Amended Answer with Counterclaims (Ex. B), Seena claims, *inter alia*, that Perine violated federal and common law unfair competition laws and infringed Applicant's valid common law rights in the DITCH PLAINS mark (Ex. B, Answer with Countercl.¶¶ 87-109). In response, Perine filed a Memorandum of Law in Opposition to Seena's Motion to Amend, setting forth precisely the same argument at issue in this Opposition -- *i.e.*, that Seena's use of the DITCH PLAINS mark is primarily geographically deceptively misdescriptive. Perine's Memorandum of Law in Opposition to Seena's Motion for Leave to Amend and Seena's Reply Memorandum, are attached hereto as Exhibits E and F, respectively. On August 21, 2013, the Court granted Seena's Motion for Leave to Amend, making the Amended Answer and Counterclaim (Ex. B) the live pleading in the Civil Action.

The key determination underlying Seena's Counterclaims in the Civil Action is whether Seena has a protectable trademark right in the same DITCH PLAINS mark at issue in this Opposition. Specifically, the Second Counterclaim in the Answer with Counterclaims (Ex. B) is a claim for unfair competition based on Seena's common law rights in the DITCH PLAINS mark under Section 43 of the Lanham Act, which requires Seena to establish its use and ownership of a protectable mark. Similarly, the Third, Fourth and Fifth Counterclaims in the Answer with Counterclaims (Ex. B) are claims for common law unfair competition, common law trademark infringement and deceptive acts under a New York statute, which also require Seena to prove it is the valid owner of a protectable mark. The validity of Seena's rights in the DITCH PLAINS mark are critical to the outcome of the trademark claims in the Civil Action pending between Seena and Perine.

Moreover, Town's Notice of Opposition in this proceeding is really just a recasting of one of the same arguments and relevant authorities set forth in section I(B)(2) of Perine's Memorandum of Law in Opposition to Seena's Motion for Leave to Amend (Ex. E). For example, paragraph 6 of Town's Notice of Opposition states:

[Seena's] application should be denied because the use of the term "Ditch Plains" in connection with [Seena's] goods is geographically deceptively misdescriptive, since these goods have no connection to Ditch Plains, Montauk.

Similarly, page 5 of Perine's Memorandum of Law in Opposition to Seena's Motion for Leave to Amend states:

Seena's goods have no connection with Ditch Plains or Montauk [citations omitted]. Therefore, Seena's use of "DITCH PLAINS" is geographically deceptively misdescriptive.

Thus, the issues raised in the Opposition are identical to trademark issues raised in the Civil Action.

II. ARGUMENT

“It is standard procedure for the Board to stay administrative proceedings pending the outcome of court litigation between the same parties involving related issues.” 6 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §32:47 (4th ed. 2013). Section 510.02 of the TBMP provides:

... pursuant to 37 CFR § 2.117(a), the Board may also, in its discretion, suspend a proceeding pending the final determination of another Board proceeding in which the parties are involved [citation omitted] ... **or even another proceeding in which only one of the parties is involved.** [citation omitted.] Ordinarily, the Board will suspend proceedings in the case before it if the final determination of the other proceeding may have a bearing on the issues before the Board. [citation omitted.]

(emphasis added); *see also New Orleans Louisiana Saints LLC and NFL Props. LLC v. Who Dat?, Inc.*, 99 SUPQ2d 1550 (TTAB 2011); *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992); *Toro Co. v. Hardigg Industries, Inc.*, 187 USPQ 689 (TTAB 1975), *rev'd on other grounds*, 549 F.2d 785, 193 USPQ 149 (CCPA 1977); *Other Telephone Co. v. Connecticut Nat'l Telephone Co.*, 181 USPQ 125 (TTAB 1974); *pet. denied*, 181 USPQ 779 (Comm'r 1974); *Tokaido v. Honda Assocs. Inc.*, 179 USPQ 861 (TTAB 1973); and *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805 (TTAB 1971).

The Board's authority includes the ability to suspend a proceeding pending the final determination of a civil action pending in a state court that involves one of the parties to the proceeding, like the Civil Action. *See Argo & Co. v. Carpetsheen Mfg., Inc.*, 187 USPQ 366 (TTAB 1975) (suspending proceeding pending state court action even though opposer was not involved in the state court action, when the action would determine ownership of applicant's mark and authority of applicant to obtain registration); *NY-Exotics, Inc. v. Exotics.com, Inc.*, Canc. No. 92040976, at 7-8 (TTAB Apr. 29, 2004) (cancellation proceeding challenging

ownership of mark NY-EXOTICS.COM suspended where “the issues involved in determining ownership of the mark NY-EXOTICS.COM are the subject of a civil action pending in [state] Court,” even though only one of the parties to the cancellation was involved in the civil action) [non-precedential]; *see also Mother's Rest. Inc. v. Mama's Pizza, Inc.*, 723 F.2d 1566, 221 USPQ 394 (Fed. Cir. 1983) (state court infringement action); *Prof'l Economics Inc. v. Prof'l Economic Servs., Inc.*, 205 USPQ 368, 376 (TTAB 1979) (decision of state court, although not binding on the Board, was considered persuasive on the question of likelihood of confusion). It is not necessary that the claims or issues be identical, or that the civil action be dispositive of the Board proceeding to warrant suspension, it need only have a bearing on the issues presented to the Board. 37 C.F.R. § 2.117(a).

The pleadings in the Civil Action clearly show that the Civil Action concerns contests over rights in the identical mark before the Board and that its adjudication has a bearing on all of the issues presented by Town in this Opposition. The disposition of the Civil Action will determine whether Seena has a protectable trademark right in the DITCH PLAINS mark, a right that is challenged by Perine in the Civil Action. (*See* Ex. C, Reply to Countercl. p.8, ¶7). More specifically, it will determine the merits of the allegations that serve as the basis of this Opposition: whether Seena's use of “Ditch Plains” is geographically deceptively misdescriptive. (*See* Ex. C, Reply to Countercl. p. 8, ¶¶ 4, 7, 8). This conclusion is further supported by the fact that Seena must establish that the DITCH PLAINS mark is a protectable trademark -- *i.e.*, that the DITCH PLAINS mark is *not* geographically misdescriptive, in order to prevail on its counterclaims for federal and common law unfair competition, common law trademark infringement and deceptive acts under a New York statute, as set forth in Counterclaims 2 through 5 of Seena's Amended Answer with Counterclaims (Ex. B). *See, e.g., Yarmut-Dion,*

Inc. v. D'ion Furs, Inc., 835 F. 2d 990, USPQ2d 1262 (2d Cir. 1987); *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 408 F.3d 596 (9th Cir. 2005).

In other words, “[i]f it is determined in the civil action that applicant’s interest in the mark was insufficient to clothe it with the authority and right to file the application, same will be declared void ab initio; in which event, the opposition will be dismissed without prejudice and registration to applicant will be refused.” *Argo*, 187 USPQ at 368. Thus, the outcome of the Civil Action will have a direct bearing on the question of Seena’s right of registration.

III. CONCLUSION

For the foregoing reasons, Seena respectfully requests that all further proceedings in the instant Opposition be suspended pending disposition of the Civil Action. In the event the Board does not rule on this Motion prior to December 2, 2013, which is Seena’s current deadline to answer or otherwise move, Seena respectfully requests that the Board suspend all deadlines in this proceeding pending disposition of Applicant’s Motion to Suspend Opposition.

Respectfully submitted,

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**ATTORNEYS FOR APPLICANT
SEENA INTERNATIONAL, INC.**

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing **APPLICANT'S MOTION TO SUSPEND OPPOSITION** has been served on Opposer by sending the same via prepaid Federal Express overnight courier, on this the 19th day of November, 2013, to:

John C. Jilnick
Town Attorney
On behalf of the Town Board
TOWN OF EAST HAMPTON
159 Pantigo Road
East Hampton, New York 11937

and was filed with the Trademark Trial and Appeal Board on the date indicated above, through the ESTTA system of the United States Patent and Trademark Office.

/ Michele P. Schwartz/
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